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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,556	12/04/2000	Pete Hesser		4098

7590 07/30/2002
Michael J. Colitz, Jr.
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EXAMINER

NEWHOUSE, NATHAN JEFFREY

ART UNIT PAPER NUMBER

3727

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,556

Applicant(s)

HESSER, PETE

Examiner

Nathan J. Newhouse

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" or "preferably" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 (line 50) recites a broad range of dimensions, and then also recites "preferably" and a specific dimension which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciancimino '170 in view of Davis et al. '143, Cassel '416 and Matthews et al. '290.

Ciancimino teaches a trash can with a cylindrical rim 16, a pair of handles on the can, and a lid 34 with a handle 46 and a sidewall 36. There are slots 18, 22 on the trash can and nodules 38, 42 to provide twist on, off locking of the lid to the trash can. Ciancimino does not teach the trash can having tapered sidewalls(although the drawings of Ciancimino appear to show the sidewall being tapered) below the cylindrical rim and the specific threads on the can and lid as set forth.

Davis et al. teaches threaded cans with cylindrical rims having threads and tapered sidewall below the rim to allow for nesting of the can when not in use. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the sidewall of the trash can of Ciancimino tapered as taught by Davis et al. below the cylindrical rim to allow for nesting of the trash can when not in use.

Cassel teaches trapezoidal threads on a lid and container to allow for sealing and fastening of the lid by rotation of between 60 and 120 degrees depending on the number and length of each thread. It would have been obvious to one of ordinary skill

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in the art at the time the invention was made to provide trapezoidal threads as taught by Cassel on the lid and trash can of Ciancimino to provide fastening and sealing of the lid by rotation of 90 degrees with respect to the trash can.

Matthews et al. teaches that it is well known to make containers and lids out of polyolefin or polyvinyl chloride. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the trash can and lid of Ciancimino out of polyvinyl chloride as it is a well known material used to make trash cans and lids known in the art.

With respect to claims 1-2 and the specific dimensions set forth in these claims, the combination as set forth discloses the claimed invention except for these specific dimensions(diameter of bottom and open top of trash can, length of the cylindrical rim, angle of threads, angle of the trapezoidal surfaces of the thread and the thickness of the trash can lid). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the trash can and lid with these specific dimensions, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

5. Applicant's arguments filed April 24, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as set forth in paragraph #4, there is motivation to combine the teachings of Ciancimino, Davis et al., Cassel and Matthews et al. Ciancimino teaches a trash can and lid that are threaded. Davis et al. teaches threaded cans having cylindrical rims and tapered sidewalls below the rim to allow for nesting. To modify Ciancimino to have a cylindrical rim and tapered sidewall as taught by Davis et al. would have been obvious to one of ordinary skill in the art to allow for the can of Ciancimino to be nested when not in use. Cassel teaches trapezoidal threads on a lid and container to allow for sealing and fastening of the lid by rotation of between 60 and 120 degrees depending on the number and length of each thread. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the trapezoidal threads as taught by Cassel on the lid and trash can of Ciancimino to provide fastening and sealing of the lid to the trash can by rotation of 90 degrees with respect to the trash can. Matthews et al. teaches that it is well known to make threaded trash cans and lids out of polyolefin or polyvinyl chloride. It would have been obvious to use either of these materials to make the trash can and lid of Ciancimino.

In response to applicant's argument concerning the applied combination lacking the trapezoidal shape of threads, the common thickness of the threads and the extent of

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the threads on the surface of the system. First, the trapezoidal shaped threads are taught by Cassel as shown in figures 2-3. With respect to the dimensions of the thread(angle of each thread(2.5-4.5 degrees), angle of each side of the trapezoidal thread(15-21 degrees) and the depth and height of each thread being 1 inch, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the trash can and lid with these specific dimensions, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the merits of the examination of the application from the examiner should be directed to Nathan J. Newhouse whose telephone number is (703)-308-4158. The examiner can normally be reached on Monday-Thursday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on (703)-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287

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Certificates of Correction	(703) 305-8309
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Nathan J. Newhouse
Primary Examiner
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July 26, 2002